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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/382,371 | 08/24/1999 | JEFFRY JOVAN PHILYAW | PHLY-24.737 | 5132 |
| 25883 | 7590 | 05/09/2006 | EXAMINER | |
| HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715 | | | NGUYEN, HAI V | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2142 | |

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/382,371 | Applicant(s) PHILYAW ET AL. | |
| | Examiner Hai V. Nguyen | Art Unit 2142 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the communication received on 21 April 2006.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 April 2006 has been entered.

3. Claims 1-17 are presented for examination.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *"In operation, the product code of a product is provided in the form of a bar code 1606. This barcode 1606 is the "link" to the product. The disclosed embodiment is operable to connect that product information contained in the bard code 1606 with a web page of the manufacture of that product by utilizing the bar codes 1606 as the product "identifier". The program operating on the PC 302 provides routing information to the ARS 308 after launching the browser on the PC 302 and connecting to the ARS 308 over the GCN 306, which ARS 308 then performs the*

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necessary steps to cause the browser to connect the manufacture web site, while also providing for an accounting step (page 34, line 22 – page 35, line 3)” does not reasonably provide enablement for “receiving unique information at the user’s location before being connected to the network, which unique information has no associated routing information embodied therein and does not identify nor is it inherently associated with a routing path to a destination location on any network” in claims 1, 14. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In Applicant’s specification, the unique information described as the unique identifier, the bar code 1606, the product identifier, is the “link” to the product. By utilizing the bar code to connect to the web page of the manufacturer of that product (page 34, lines 23-27). What is claimed in claims 1, 14, is that, “the unique information does not identify nor is it inherently associated with a routing path to a destination location on any network”. How come the bar code does not identify nor link to the manufacturer of the product identified by the bar code?

Claim Objections

6. Claims 1 and 14 contain the negative limitation, e.g., receiving unique information at the user’s location before being connected to the network, which unique information has no associated routing information embedded therein and does not identify nor is it inherently associated with a routing path to a destination location on any networks;

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be

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explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by **Gifford** U.S patent # **5,812,776**.

9. As to claim 1, Gifford, Method Of Providing Internet Pages By Mapping The telephone Number Provided By Client To URL And Returning The Same In A Redirect Command By Server, discloses a method for interconnecting a user's location (*client*) on a network (*Internet*) to a select one of a plurality of destination locations (*Merchant Server*) on the network, comprising the steps of:

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receiving unique information (*Fig. 6, get "number" which is telephone number or flight number, or reservation number or other identifier*) at the user's location before being connected to the network, which unique information has no associated routing information embedded therein and the purpose thereof not routing to the particular destination on the network (*Gifford, Abstract, col. 3, lines 6-30*); assembling a data transmission containing a representation of the unique information; transmitting the data transmission to an intermediate node (*directory server*) on the network having associated therewith a database (*Gifford, Abstract, col. 3, lines 6-30*);

receiving from the intermediate node on the network instructional code (*Redirect command*) that was generated at the intermediate location as a result of the transmission of the data transmission thereto, which instructional code includes routing information (*Target URL*) that instructs the user location to connect to one of the plurality of destination locations (*Merchant server*) on the network that has defined association with the representation of the unique information defined in a database (*Number-to-URL database*) at the intermediate location on the network (*Gifford, Abstract, col. 3, lines 6-30; col. 7, line 1 – col. 8, line 52*).

interconnecting, in response to the step of receiving from the intermediate location on the network instructional code and without any intervention at the user location, the user's location to the one of the plurality of destination locations across the network in accordance with the network routing information and accordance with the received instructional code such that connection to the one of the plurality of destination locations is controlled by the intermediate location in accordance with the defined association

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between the representation of the unique information received at the user location and the routing information to the one of the plurality of destination locations on the network (*Gifford, Abstract, Figs. 2A-2B; col. 3, lines 6-30; col. 4, line 20 – col. 5, line 65; col. 8, lines 13-23*).

10. As to claim 2, Gifford discloses the network comprises a global communication network (*Gifford, Internet*).

11. As to claim 3, Gifford discloses the step of receiving the unique information comprises receiving machine-readable code having unique information embedded therein (*Client inputs the number, message 1 in Fig. 6; col. 7, lines 47-65*).

12. As to claim 4, Gifford discloses the step of receiving the machine readable code comprises scanning the machine readable code, decoding the machine readable code and outputting the information encoded within the machine readable code as the representation of the unique information (*Client inputs the number, message 1 in Fig. 6; col. 7, lines 47-65*).

13. As to claims 5-8, Gifford discloses the number or other identifiers, which are machine-readable code. Therefore, the product code, barcode, ISBN number and EAN code are merely the numbers or identifiers, which are machine-readable, code.

14. As to claim 9, Gifford discloses, further comprising the step of receiving from the one of the plurality of destination locations at the user location display information generated by the one of the plurality of destination locations which is displayed to a user at the user location after interconnection to the one of the plurality of destination locations by the step of interconnecting (*col. 7, line 1 - col. 8, line 52*).

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15. As to claim 10, Gifford discloses the step of receiving from the intermediate location on the network instructional code comprises:

comparing the received representation of unique information at the intermediate location with a database of routing information, which database of routing information includes a plurality of associative relationships between predetermined representations of unique information and locations of various ones of the plurality of destination locations on the network (*col. 7, line 1 - col. 8, line 52*) and

if an association between the received representation of unique information and routing information on any of a plurality of destination locations on the network exists within the database, returning the associated routing information as part of instructional code back to the user location for effecting a network connection to the one of the plurality of destination locations indicated by the routing information in the step of interconnecting (*col. 7, line 1 - col. 8, line 52*).

16. As to claim 11, Gifford discloses, wherein the step of interconnecting includes the step of activating a web browser program which facilitates the interconnection over the network in response to receiving the instructional code including the routing information, which web browser program is operable to at least provide the interconnection of the user location to the destination location in accordance with the associated routing information under control of the intermediate location (*col. 7, line 67 - col. 8, line 52*).

17. As to claim 12, Gifford discloses, wherein the step of assembling a data transmission comprises assembling a message packet containing a representation of the unique information (*number or other identifiers*).

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18. As to claim 13, Gifford discloses, wherein the step of assembling the message packet comprises forming a data transmission that is comprised of a first field having associated therewith source information as to the location on the network of the user location, a second field having associated therewith destination information as to the location of the intermediate node on the network and a third field having associated therewith the representation of the unique information (*SID and number/identifier*).

19. Claim 14 is similar limitations of claim 1; therefore, it is rejected under the same rationale as in claim 1.

20. Claims 15-17 are similar limitations of claims 4, 9, 10; therefore, they are rejected under the same rationale as in claims 4, 9, 10.

21. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

Response to Arguments

22. Applicant's arguments filed on 21 April 2006 have been fully considered but they are not persuasive. The last Final Office stands.

23. In the remark, Applicant argued in substance that:

Point (A), the prior art does not disclose an input a unique code that has no routing information contained therein.

As to point (A), Gifford discloses the "number" which is telephone number or flight number, or other identifier which merely the computer codes or scripts appended in the URL at the intermediate location, e.g., directory server, which can be programmed or scripted in the computer programming language and readable by the

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computer. By changing the phone number readable by the computer by other number like product identifier or barcode number readable by the computer and referenced or linked to the corresponding URL in the translation table (or translation database) in order to redirect the browser user to that URL, e.g., connected to the web page of the manufacturer of that product (Applicant's specification, page 34, lines 23-27).

These computer readable identifiers/numbers are not distinguishable, just small modifications in the computer program codes. They are not patentable subject matter as claimed because providing the product identifiers/URLs translation table is also well known in the networking art as evidenced in the figure 5, col. 6, line 40 – col.7, line 19 of Golden et al. US patent 6,401,077.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
Art Unit 2142



THOUER M
P.E.
